

REMARKS

Favorable reconsideration and allowance of the claims of the present application are respectfully requested.

Applicants observe that Claims 1-24 are pending in this case and those claims have been rejected under 35 U.S.C. § 103 as allegedly unpatentable over the disclosure of U.S. Patent No. 6,841,457 B2 to Bedell, et al. ("Bedell, et al.").

Insofar as the § 103 rejection is concerned, applicants submit that the statute under 35 U.S.C. § 103(c) states that:

Subject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Applicants submit that the Bedell, et al. reference was applied by the Examiner as prior art under 35 U.S.C. § 103 via 35 U.S.C. § 102(e). Applicants observe that both the applied U.S. Patent of Bedell, et al. and the corresponding Published U.S. Application were printed after the filing date of the present application. Applicants further note that the list of inventors in the present application are different than the list of inventors in the Bedell, et al. patent and as such Bedell, et al. was developed by another person. Applicants further note in this regard that MPEP § 706.02(k) states that:

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. § 103 via 35 U.S.C. § 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

This change to 35 U.S.C. § 103 is applicable to all utility, design, and plant applications filed on or after November 29, 1999 including continued prosecution applications (CPA) filed

under 37 C.F.R. § 1.53(d). Applicants note that the present application was filed on September 3, 2003; therefore the present application is entitled to the above change in 35 U.S.C. § 103.

In view of this, and the fact the present application and Bedell, et al. "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person", the Bedell, et al. reference is disqualified as a reference under 35 U.S.C. § 103(c).

To evidence that the instant application and Bedell, et al. "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person", the assignment document of the present application (recordation date September 3, 2003 at Reel 014482, Frame 0827) was compared with the recorded assignment of Bedell, et al. (recordation date July 16, 2002 at Reel 013116, Frame 0687). In both instances, the inventors conveyed their entire interest to International Business Machines Corporation; therefore establishing common ownership between the instant application and Bedell, et al.

In view of the above information, Bedell, et al. are disqualified as art. The instant § 103 rejection based solely on Bedell, et al. has thus been obviated.

In view of the above remarks, the rejection under 35 U.S.C. § 103 has been obviated; therefore reconsideration and withdrawal thereof are respectfully requested.

Respectfully submitted,


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